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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,322	10/21/2003	Timothy C. Owens	018360/246794	4551

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EXAMINER
NGUYEN, CAM LINH T

ART UNIT	PAPER NUMBER
2161	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)
	10/690,322	OWENS ET AL.
	Examiner	Art Unit
	CamLinh Nguyen	2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>20 November 2006</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>39-45</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>39-45</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>21 October 2003</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   This Office Action is response to amendment filed on 11/20/2006.

2.   Claims 39 – 45 are currently pending, not 29 – 45 as Applicant presented.

Claim Rejections - 35 USC § 101

3.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4.   Claims 39 – 45 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter.

Claims 39 - 45 appear to be an abstract idea rather than a practical application of the idea;

claims 39 - 45 do not result in a physical transformation nor do they appear to provide a useful,

concrete and tangible result. Specially, they do not show any "tangible result" because the

Applicant merely describes a system that comprises several different components (claim 39) and

provides a database that can be connected to other databases (claim 39). However, applicant fails

to disclose how these components can be used to produce a tangible result. The Examiner did not

see any result from the system as claimed in claims 39 - 45. Therefore, claims 39 - 45 appear

non-statutory.

5.   To expedite a complete examination of the instant application the claims rejected under

35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of

application amending these claims to place them within the four statutory categories of

invention.

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

7.   This application currently names joint inventors. In considering patentability of the

claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

claims was commonly owned at the time any inventions covered therein were made absent any

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c)

and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8.   Claims 39 – 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benjamin

D. Goldstein (U. S. 5,963,642) in view of Musa et al (U.S. 5,710,917).

♦ As per claim 39,

Goldstein discloses an address management system comprising:

-       " A superset comprising a primary database operatively connected to one or more

        secondary databases, each of said databases comprising a plurality of linked tables, and

        each of said tables sharing a common data structure" See Fig. 5, 6A – 6B, in particular:

        •   "Primary database corresponds to the "database" in the database server 30 in Fig.

            5 of Goldstein.

- • "One or more secondary databases" See col. 13, lines 8 – 11, wherein Goldstein

    discloses that one or more database server are attached as shown in Fig. 6B of

    Goldstein.

- • "Each of said databases comprising a plurality of linked tables" Since the

    database in Goldstein is a RDBMS, therefore, the database must include plurality

    of linked tables (See col. 20, lines 20 – 44 of Goldstein).

- " An enhancement module configured to transform one or more of said tables into a

    sparse matrix linked list" corresponds to the module that is implemented in the database

    to produce the sparse matrix linked list (see col. 9, lines 10 – 28 of Goldstein).

- " A publication and subscription module for controlling the distribution of data in a

    server-client network environment" corresponds to the communication port in Fig. 5, col.

    15, and lines 21 – 25 of Goldstein. The "publication and subscription module" also

    corresponds to the "trusted key server" that can be used to distribute information in Fig.

    10, col. 23, lines 38 – 54 of Goldstein.

- " And an interface for controlling access to said superset by one or more external

    applications" See Fig. 5 of Goldstein, wherein the interface corresponds to the input port

    2 in the end user workstation.

Goldstein does not clearly disclose: " A matching and validation module for converting a

subjective representation of an address into a preferred representation of said address".

However, Musa, on the other hand, discloses a method for deriving data mappings and data

aliases (see the title of Musa) comprising a method for transform data from one format of a

database to another format to another database (See Fig. 7, col. 7, lines 57 – col. 8, lines 5 of

Musa). The data can be the address data (col. 5, lines 55 – 58 of Musa). Therefore, Musa

discloses a module that can be able to convert a "subjective representation of an address" (five

digits zip code data) into a "preferred representation of said address" (nine digits zip code data).

Goldstein discloses a method for secure storage of data for the use to access the data and

suggests that modified can be made without departing from the scope of the invention (col. 27,

lines 17 – 22 of Goldstein). Since both Goldstein and Musa are in the same field of endeavor, it

would have been obvious to one with ordinary skill in the art at the time the invention was made

to apply the teaching of Musa into the invention of Goldstein because the combination would

provide the user the ability to retrieve more data using the mapping disclosed by Musa.

♦ As per claim 40, the combination of Goldstein and Musa disclose:

-   "Wherein said enhancement module is further configured to arrange the records of one or

    more of said tables in hierarchical order, in a series of levels from general to specific,

    based upon said data" See Col. 14, lines 24 – 28 of Goldstein.

♦ As per claim 41, the combination of Goldstein and Musa disclose:

-   "Wherein: said primary database includes source tables, a first secondary database

    includes alias tables, a second secondary database includes standardization tables, and a

    third secondary database is configured to accept and store input data". Musa discloses a

    method to convert data from one format of a storage to another format of another storage

    (col. 7, lines 57 – 58 of Musa) using the alias table data (col. 9, lines 7 – 9 of Musa). As

    in combination with Goldstein invention, the combination would produce:

    •   A primary database (Goldstein) include source table (first data format from the

        primary database) (Musa invention).

- A first secondary database (since Goldstein suggest that multiple database can be included at col. 13, lines 10 – 11) includes alias tables (using Musa alias table, in claim 7 – 8).

- A standardization tables corresponds to the second format of the data after using the mapping to transform (using Musa invention).

- "A third secondary database is configured to accept and store input data" corresponds to the end user database in Goldstein.

♦ As per claim 42, the combination of Goldstein and Musa disclose:

  - "Wherein: said source tables comprise data records obtained from a public or private source (See col. 5, lines 49 – 67 of Musa where the data can be from federal or sate (corresponds to public source)), said alias tables comprise one or more equivalent representations of a record (col. 9, lines 7 – 9 of Musa), and said standardization tables comprise one or more standardized representations of a record" Since the nine digits zip code corresponds to the standardization data (Musa), therefore, the table that contains the nine digits zip code corresponds to the standardization table.

♦ As per claim 43, the combination of Goldstein and Musa disclose:

  - "Wherein said source tables comprise address records obtained from a government postal service and a commercial source" See col. 5, lines 55 – 58 of Musa.

♦ As per claims 44 - 45, the combination of Goldstein and Musa disclose:

  - "Wherein: a first table includes preferred records, a second table includes primary alias records, and a third table includes secondary alias records" and "wherein: said preferred records comprise one or more preferred representations, said primary alias records

comprise one or more equivalent representations of a primary address artifact, and said

secondary alias records comprising one or more equivalent representations of a secondary

address artifact" See col.9, table 2 from lines 15 – 25 of Musa. Again, the preferred

records correspond to the nine digits zip code data in Musa reference. If there are two

formats in the database, they must have at least two preferred representations. Musa

discloses that a data filed can have different aliases. Therefore, one skill in the art would

break this table into two or three tables, and then the system would have first and second

aliases tables.

Response to Arguments

9.   Applicant's arguments filed 11/20/2006 have been fully considered but they are not

persuasive.

♦ Applicant argues that the claims 39 – 45 provide a useful, concrete and tangible result. The

Examiner respectfully disagrees.

As previously indicated, claim 39 provides a serial modules for perform a certain

functions. Claim 39 is directed to software, per se, lacking storage on a medium, which enables

any underlying functionality to occur. The function that after the term "for" is considered as

intended of use and do not carry much weight in the claim language. Therefore, the claims 39 –

45 are still non statutory.

♦ Applicant argues that the references fail to disclose, "converting a subjective address format to

a preferred address format. The Examiner respectfully disagrees.

The claim language called for "converting" form one format to another format. Musa discloses that the addresses can be mapped to another format (one format to another format). Therefore, the Musa patent does anticipate the current claim language.

♦ Applicant argues that the references Musa does disclose potentially altering the syntax but not the semantics. The Examiner respectfully disagrees.

The claim language did not claim this limitation.

♦ Applicant argues that the references fail to indicate what rules are to be used for replacing a field in a record or under what circumstances a particular alias is to be used. The Examiner respectfully disagrees.

The claim language did not claim this limitation.

♦ Applicant argues that the Goldstein reference fails to disclose "tables in a hierarchical order". The Examiner respectfully disagrees.

Referring to col. 14, lines 4 – 30, the Property column "may actually take on a more extend hierarchical structure". Clearly, the record must be placed in a hierarchical structure.

Conclusion

10.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

11.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to CamLinh Nguyen whose telephone number is (571) 272 - 4024.

The examiner can normally be reached on Monday-Friday.

        If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Jeffrey Gaffin can be reached on (571) 272 - 4146. The fax phone number for the

organization where this application or proceeding is assigned is 571 – 273 - 8300.

        Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nguyen, Cam-Linh

Art Unit 2161

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